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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Hoppensteadt et al.

Application No: 09/771,019

Confirmation No: 6361

Filed: 01/26/2001

For: PHASE LOCK LOOPED OSCILLATORY NEUROCOMPUTER

Examiner: Hirl, Joseph P.

Art Group: 2129

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COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

In the Notice of Allowance mailed May 1, 2007 (hereinafter "NOA"), the Examiner states that the Reasons for Allowance dated October 14, 2004 (hereinafter "First Allowance") and the Supplemental Notice of Allowance dated February 24, 2005 (hereinafter "Supplemental Allowance") fully apply. Applicants respectfully disagree and submit that the statements provided in the Supplemental Allowance are improper.

According to 37 CFR 1.104(e), the Examiner may provide reasons for allowance when the Examiner believes that record of prosecution as a whole does not make clear the reasons for allowance. Further interpreting 1.104(e), MPEP 1302.14 states that care must be taken by the Examiner to ensure that the statements of reasons for allowance are accurate, precise, and do not place unwarranted interpretations, whether narrow or broad, upon the claims. Adding further emphasis to this point, the United States Supreme Court stated in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741 (2002), that it is improper to use reasons for allowance to attempt to

narrow a claim limitation by providing a special definition to the limitation if that special definition is not presented in the original disclosure.

In the Supplemental Allowance, the Examiner twice provides special definitions of the limitations of claims 19 and 20 (then claims 18 and 20) that place narrow, unwarranted interpretations on those claims.

More specifically, on page 2 of the Supplemental Allowance, the Examiner states that Applicant defines "neural network computer" in the Abstract. While the Abstract, like the rest of the original disclosure, may be used in interpreting the claims, limitations of the Abstract and disclosure not recited in the claims may not be read into the claims. For further discussion of this point, MPEP 2111.01 is particularly enlightening (see also, *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970), and *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Circ. 2004)). Rather, words in patent claims are to be given their ordinary meaning in the usage of the field of the invention unless the applicant has provided a clear definition in the Specification (see MPEP 2111.01, as well as, for example, *In re Zletz*, 893 F.2d 319, 321 (Fed. Circ. 1989)).

Regardless of whether the Abstract is enlightening in interpreting claims 19 and 20, the Abstract does not provide a clear definition of "neural network computer." Instead, the Abstract simply describes an embodiment of the invention to convey the "nature and gist of the technical disclosure", as required by 37 CFR 1.72(b). Nowhere in the Abstract do Applicants use the term "defines". Further, Applicants expressly disclaim any special definitions or meanings of terms in the final paragraph of the Specification, page 11, lines 15-17 ("it is intended that the invention shall be limited only to the extent required by the appended claims and the rules and principles of applicable law").

Because applicable law requires that "neural network computer" be interpreted according to its ordinary meaning within the art, absent a clear, special definition of that

term in the Specification, and because the Specification expressly disclaims any special definitions, the Examiner's statement that "Applicant defines 'neural network computer' in the abstract..." is improper.

Additionally, the Examiner likewise states that "claim 18 carries all the limitations of Fig. 1" and that "Fig. 1 is further defined on page 4 and 5 of the specification." This statement explicitly reads the limitations of the Specification (Fig. 1) into claim 18, and thus stands in violation of the applicable law discussed above. Limitations of the Specification can only be read into the claims when they constitute clear, special definitions of the claim language. Nothing in Figure 1 or its corresponding description indicate that they are intended to define the recitations of claim 19 (equivalent to previous claim 18), or the term "neural network computer" specifically. In fact, on page 4, lines 8-9 of the Specification, Applicants state "Figure 1 schematically illustrates an oscillatory neural network computer 20 in accordance with an embodiment of the invention" (emphasis added). Thus, Applicants clearly intend that Figure 1 describe an embodiment, and do not provide that figure or its description as a special definition of "neural network computer." Accordingly, the limitations are to be given their ordinary meaning in the art, and DO NOT carry all the limitations of Figure 1, as improperly alleged by the Examiner.

Lastly, Applicants question the necessity of again applying both the First and Supplemental Allowances. In addition to the above improper interpretations of claims 19 and 20, the First and Supplemental Allowances also contain summaries of two of the cited references and discussions of how those references differ from the claims. Regardless of whether those summaries and discussions were necessary in view of the record as the whole at the times they were provided, Applicants respectfully assert that they are no longer necessary. Both references have been amply discussed in the Examiner's rejections and in Applicants' responses, and the reasons for allowance are now clear from a review of the record as a whole.

Accordingly, Applicants respectfully request that the Examiner withdraw the statements of Reasons for Allowance mailed May 1, 2007. At the very least, Applicants request that the Examiner correct the record and repudiate the assertions in the Supplemental Allowance that "Applicant defines 'neural network computer' in the abstract" and that "claim 18 carries all the limitations of Fig. 1." For the reasons given above, these statements from the Supplemental Allowance are clearly improper.

Respectfully submitted,
Schwabe, Williamson & Wyatt, P.C.

Dated: July 31, 2007

Robert C. Peck
Reg. No. 56,826

Pacwest Center, Suite 1900
1211 SW Fifth Avenue
Portland, Oregon 97204
Telephone: 503-222-9981